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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/776,069
Filing Date: February 11, 2004
Appellant(s): SANDERS ET AL.

Sue Z. Shaper
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/28/2010 appealing from the Office action mailed 11/20/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Pricewatch (www.pricewatch.com, webpages from 1/28/2003), Yahoo (www.yahoo.com, webpages from 12/09/2002), Morimoto (Publication Number 2002/0013774), eBay (www.ebay.com webpages from 11/15/2002), Google (www.google.com webpages from 2/22/2002), Lee et al. ('Lee' hereinafter) ("From Design Features to Financial Performance: A Comprehensive Model of Design Principles for Online Stock Trading Sites", Journal of Electronic Commerce Research, Vol 3, No. 3, 2002)

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11, 13-37, 39 and 41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Pricewatch (www.pricewatch.com, webpages from 1/28/2003) in view of Yahoo (www.yahoo.com, webpages from 12/09/2002) and further in view of Lee et al. ('Lee' hereinafter) ("From Design Features to Financial Performance: A Comprehensive Model of Design Principles for Online Stock Trading Sites", Journal of Electronic Commerce Research, Vol 3, No. 3, 2002).

As per claim 1, Pricewatch teaches

An improved Internet Directory System, comprising: (page 1)

a lower level directory comprehensively referencing viable websites (WSs) relating to a category; (page 2)

the CDWs being identified participating in the System by the display by each CDW of a common licensed service mark, or a common URL portion functioning as a service mark, the common service mark being displayed by the hundreds of CDWs to indicate participation in a unique source of an internet directory system; (page 3)

and a business model imposed on the CDWs, by the DP or System, including standards of operation with respect to the provision of lower level directories. (pages 4-5)

Pricewatch does not explicitly indicate "at least one upper-level Directory Provider (DP), providing an upper-level directory of lower-level directories, the upper-level directory organized by at least upper-level fields and/or super-categories and categories (together, upper-level categories), and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit lower-level directories Category Directory Websites (CDWs) related to the upper-level categories, the CDW's organized by lower-level categories and subcategories" nor "the hundreds of CDWs each providing at least".

However, Yahoo discloses "at least one upper-level Directory Provider (DP), providing an upper-level directory of lower-level directories, the upper-level directory organized by at least upper-level fields and/or super-categories and categories (together, upper-level categories), and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit lower-level directories Category Directory Websites (CDWs) related to the upper-level categories, the CDW's organized by lower-level categories and subcategories" (page 1) and "the hundreds of

CDWs each providing at least" (page 1; it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bernis Co.*, 193 USPQ 8)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "at least one upper-level Directory Provider (DP), providing an upper-level directory of lower-level directories, the upper-level directory organized by at least upper-level fields and/or super-categories and categories (together, upper-level categories), and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit lower-level directories Category Directory Websites (CDWs) related to the upper-level categories, the CDW's organized by lower-level categories and subcategories" nor "the hundreds of CDWs each providing at least" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

Neither Pricewatch nor Yahoo "of uniform organization, comprehensiveness of reference and up-to-dateness"

However, Lee discloses "of comprehensiveness and up-to-dateness" (up-to-datedness and indepth analysis, table 1, page 132).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo and Lee because using the steps of “of comprehensiveness and up-to-dateness” would have given those skilled in the art the tools to improve the invention by providing important features on an e-commerce site to attract more business. This gives the user the advantage of being able to keep up with the latest trends and information.

As per claim 2, Pricewatch teaches

The CDWs are identified as participating in the System by display of a common URL portion. (page 5)

As per claim 3, Pricewatch teaches

the business model includes a standard of operation providing professional management. (page 5)

As per claim 4, Pricewatch teaches

the URL portion includes a TLD. (pages 1-3)

As per claim 5, Pricewatch teaches

the business model includes a standard of operation providing a comprehensive listing of viable websites (WSs) related to the category for no charge. (page 4)

As per claim 6, Pricewatch teaches

the business model includes a standard of operation, imposed on at least a subset of CDWs, providing a CDW offering web sites at least one of an option to move to a secure site to negotiate a purchase and an organization of pertinent comparative data on a subject within the category. (page 3 and 5)

As per claim 7, Pricewatch teaches

the business model includes charging at least some WSs for enhanced reference. (page 5)

As per claim 8, Pricewatch teaches

the business model includes at least some WSs being charged for at least one service offered by a CDW. (page 5)

As per claim 9, Pricewatch teaches

the business model includes a participating CDW providing advertising space on its site. (page 3)

As per claim 10, Pricewatch teaches

the business model includes a CDW promoting, by advertising, at least one of its referenced websites. (page 3)

As per claim 11, Pricewatch teaches

the business model includes at least one advertising/promotion firm that provides advertising/promotion for a category and/or a CDW site substantially in return for advertising space on a CDW site. (page 3)

As per claim 13, Pricewatch teaches

the business model includes substantially funding operation of a CDW by payments from WSs. (page 4-5)

As per claim 14, Pricewatch teaches

the business model includes selection of categories for CDWs large enough to support a Category Directory Website and small enough to be managed according to the business plan. (page 1-2)

As per claim 15,

Pricewatch does not explicitly indicate "the System includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs with respect to at least one upper level category."

However, Yahoo discloses "the System includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs with respect to at least one upper level category." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the System includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs with respect to at least one upper level category" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 16, Pricewatch teaches
the URL portion consists essentially of a TLD. (page 3)

As per claim 17, Pricewatch teaches
the URL portion comprises a TLD unique to CDWs and DPs in the system. (page
3)

As per claim 18, Pricewatch teaches
the business model includes at least website enhancement technology cost
effectively offered to appropriate referenced WSs. (page 3)

As per claim 19,
CDW's provide a comprehensive reference to WSs without charge to the WSs.
(page 3-4)

As per claim 20,

Pricewatch does not explicitly indicate "the Directory Provider comprises an ISP or Search Engine."

However, Yahoo teaches "the Directory Provider comprises an ISP or Search Engine." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the Directory Provider comprises an ISP or Search Engine" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 21, Pricewatch teaches

1) the category and 2) at least one field and/or super-category are both more than simply an indicator of city, state, region or nation. (page 3)

As per claims 22-36,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 1-2,16-18,3-5,9-10,20,11,6-7,21 and are similarly rejected.

As per claim 37, Pricewatch teaches

the business model includes minimal standards for websites to be included in a directory, for updating website references including adding new websites and for deleting no longer viable websites and standards for certain quality of presentation for participating websites. (page 5)

As per claim 39, Pricewatch teaches

the upper level fields and/or super-categories and categories being organized to contain CDWs which pay the DP to be listed in one or more fields, the fee based on a number of web pages hosted or linked to the CDW. (page 5)

As per claim 41, Pricewatch teaches

Pricewatch does not explicitly indicate "the hundreds includes thousands".

However, Yahoo discloses "the hundreds includes thousands" (page 1; it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the hundreds includes thousands" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-

known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 42, Pricewatch teaches
the CDWs providing lists of business and/or web pages within their category and organizing those lists into sub-categories. (page 2)

As per claim 43, Pricewatch teaches
The directory website remitting value to a DP or system (page 2)

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo and Lee, and further in view of Morimoto (Publication Number 2002/0013774).

As per claim 12,
Neither Pricewatch, Yahoo nor Lee explicitly indicate "the business model includes offering webpage enhancement services at a volume discount."

However, Morimoto discloses "the business model includes offering webpage enhancement services at a volume discount" (paragraph [0008]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and Morimoto because using

the steps of "the business model includes offering webpage enhancement services at a volume discount" would have given those skilled in the art the tools to improve the invention by allowing economies of scale to determine prices. This gives the user the advantage of being able to get better prices if willing to spend more money.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo, Lee and further in view of eBay (www.ebay.com webpages from 11/15/2002).

As per claim 38,

Pricewatch does not explicitly indicate "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to websites, such services tailored to a category and specifically designed to attract and retain viewers".

However, eBay discloses "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to websites, such services tailored to a category and specifically designed to attract and retain viewers" (table 6, listing enhancements).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and eBay because using the steps of "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo, Lee and further in view of Google (www.google.com webpages from 2/22/2002).

As per claim 40,

Pricewatch does not explicitly indicate "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated".

However, Google discloses "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the

CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and Google because using the steps of "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

(10) Response to Argument

As per claims 1, 22, 24 and 25, Applicant argues that the displaying of a common licensed service mark is not taught as displayed by Pricewatch. It is respectfully submitted that the claim language says "a commonly licensed service mark, or a common URL portion functioning as a service mark", and it is respectfully submitted that Pricewatch teaches the "buy-online" is a common URL portion which functions as a service mark (page 3). The Applicant argues that this "buy-online" portion is not prohibited from being used by others and therefore is not a service mark. It is submitted that the term "service mark" is not found anywhere in the Applicant's specification and

therefore can be give the broadest reasonable interpretation. As previously submitted, this is a common mark which indicates a particular service offered, and therefore the Pricewatch reference does teach this limitation.

As per claims 4 and 25, Applicant argues that Yahoo does not teach "hundreds" or "thousands" of CDs, however as previously submitted it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bernis Co.*, 193 USPQ 8). Applicant argues that the plurality shown in Yahoo cannot be expanded to the hundreds as claimed by the applicant, however it is further submitted that the Yahoo engine which constructs the list is simply duplicating the working parts and since such duplication has been done a plurality of times it is even more evident that duplication could be done into the hundreds supported by *St. Regis Paper Co. v. Bernis Co.*, 193 USPQ 8.

As per claims 1 and 22, Applicant argues that Lee does not teach the up-to-dateness and that his business model teachings are different than that used in the claimed invention. It is respectfully submitted that the up-to-dateness of a website as taught by Lee (page 132, table 1) can be used to modify the primary reference in terms of keeping a website up-to-date. The Pricewatch and Yahoo references teach the pertinent limitations related to the claimed subject matter, and adding the Lee reference

to teach the additional element related to websites and business requirements would be the same regardless of the particular business performed online. These concepts are equivalent across any business online and it is simply prudent to ensure that a website does not contain stale data which does not accurately describe information to a customer. Therefore it is respectfully submitted that a combination of the cited references does teach these limitations.

As per claims 3 and 5, Applicant argues that Pricewatch does not provide for the limitation of the business model including a standard of operation providing professional management. It is respectfully submitted that the requirement listed on page 5 of the Pricewatch reference teaches, among other things, providing tech support. This can be considered professional management since the limitation can be broadly interpreted since it is not further defined in terms of what is being managed. In addition, the requirement that the advertising business have at least 1 year of business also means that the business would inherently have professional management since a business cannot run for such a length without such management. Therefore it is submitted that the limitations are taught by the cited references.

As per claims 15, 19 and 43, applicant argues that neither Pricewatch or Yahoo teach comprehensiveness of lower-level directories, comprehensively referencing websites without charge by lower-level directories or a contractual relationship between the upper-level directory and the independent lower-level directory that it references.

Regarding the comprehensiveness of lower-level directories, it is submitted that Pricewatch seems to disclose a comprehensiveness in their listings, and regardless a comprehensiveness is really relative to the user, and perhaps a user that could find two different vendors would consider that comprehensive. Regarding the comprehensive referencing without charge limitation, if Pricewatch does not teach this limitation then it is respectfully submitted that Yahoo does not disclose any charge for its services and one of ordinary skill in the art would have contemplated that the listing service might be free. With regards to the comprehensiveness, again this is relative to the user. With respect to remitting value to the upper-level directory provider, it is submitted that value is not defined specifically as a monetary value. Perhaps the value can be remitted via the simple act of the lower-level directory deciding to list with the upper-level provider. Regardless, Pricewatch does charge for its services and so value is remitted to the upper-level directory provider for the services provided and that is a type of value remitted.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR*

International Co. v. Teleflex, Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

Conclusion:

It is respectfully submitted that a combination of the references cited disclose the claimed CDW system. In light of the forgoing arguments, the examiner respectfully requests the honorable Board of Appeals and Interferences to sustain the rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

/Jay Morrison/

Jay Morrison, Patent Examiner, AU 2168

April 26, 2010

Conferees:

Art Unit: 2168

/Tim T. Vo/

Supervisory Patent Examiner, Art Unit 2168

/Pierre M. Vital/

Supervisory Patent Examiner, Art Unit 2156